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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/594,798

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EXAMINER

BLANCO, JAVIER G

ART UNIT

PAPER NUMBER

3774

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12/08/2011

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/594,798	<b>Applicant(s)</b> TOWNSEND ET AL.	
	<b>Examiner</b> JAVIER BLANCO	<b>Art Unit</b> 3774	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 9/28/2011.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 5) ☒ Claim(s) 43, 44, 46-49 and 53 is/are pending in the application.
- 5a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 6) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 7) ☒ Claim(s) 43, 44, 46-49, and 53 is/are rejected.
- 8) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 9) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____.                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.   | 6) <input type="checkbox"/> Other: ____.                          |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicants' amendment of claims 43, 44, and 46 in the reply filed on **September 28, 2011** is acknowledged.
2. Applicants' cancellation of claims 50 and 51 in the reply filed on **September 28, 2011** is acknowledged.
3. Applicants' addition of claim 53 in the reply filed on **September 28, 2011** is acknowledged.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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**5.** Claims 43, 44, and 46-51 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. **7,955,399 B2**.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between claims 43, 44, and 46-51 of the application and claims 1-6 of U.S. Patent No. **7,955,399 B2** lies in the fact that the patent claims include many more elements and is thus much more specific. Thus the invention of claims 1-6 of U.S. Patent No. **7,955,399 B2** is in effect a “species” of the “generic” invention of claims 43, 44, and 46-51. It has been held that the generic invention is “anticipated” by the “species”. See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claims 43, 44, and 46-51 of the application are anticipated by claims 1-6 of U.S. Patent No. **7,955,399 B2**, it is not patentably distinct from claims 1-6 of U.S. Patent No. **7,955,399 B2**.

**6.** Claims 43, 44, and 46-51 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over pending claims of copending Application No. **12/886,758**.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the above-indicated applications claim a resilient foot (or foot plate) and a resilient leg portion including a plurality of elongated, upwardly extending, substantially vertically oriented resilient members which are spaced apart in the sagittal plane intermediate their upper and lower ends and which are anterior facing convexly curved at their lower ends. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 43, 44, 47-49, and 53 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by **Christensen** (US 6,929,665 B2).

Referring to Figures 4-6, **Christensen** '665 discloses a lower extremity prosthesis comprising:

a semi-rigid, resilient foot keel (Figure 4 and Figure 5: keel 18; Figure 6: keel 114);

a semi-rigid, resilient leg portion attached to the foot keel;

wherein the semi-rigid, resilient leg portion includes a plurality of elongated, upwardly extending, generally arcuately curved in the sagittal plane, substantially vertically oriented (broadly interpreted as “orienting upwardly”, as opposed to laying down completely horizontal), semi-rigid, resilient members (Figure 6: resilient members 112 and 514) which are spaced apart in the sagittal plane intermediate their upper and lower ends and which are anterior facing convexly curved at their lower ends to form an ankle joint area of the prosthesis and which extend upwardly above the ankle joint area to a substantially vertically oriented upstanding upper end (64) of the leg portion, at least one of said plurality of semi-rigid, resilient members is wider in the frontal plane than thick in the sagittal plane, the semi-rigid, resilient leg portion storing

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energy during force loading of the prosthesis and returning energy during force unloading *to increase the kinetic power* generated for propulsive force by the prosthesis.

Regarding claim 44, see Figure 6 wherein the members are fastened at their upper and lower ends.

Regarding claim 47, see bolts/nuts shown in Figure 6.

Regarding claim 48, any of the bends could be broadly interpreted as a "stop".

Regarding claim 49, see plate 160 (Figure 6).

Regarding claim 53, the resilient members of the leg portion are leaf spring type members.

### ***Claim Rejections - 35 USC § 103***

**9.** The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**10.** Claims 43, 44, 46-49, and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Atkinson et al.** (US PG Pub No. 2002/0087216 A1; cited in Applicants' IDS) in view of either one of **Allen et al.** (US 5,653,767 A; cited in Applicant's IDS) and/or **Christensen** (US 6,929,665 B2).

Referring to Figures 11, 13, 14, 19, and 20, **Atkinson et al.** disclose a prosthetic foot comprising:

(i) A semi-rigid, resilient foot keel (Figure 11: foot 454/456/458; Figure 13: foot 454/456/458; Figure 20: foot 754/756/758);

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(ii) A semi-rigid, resilient leg portion attached to the foot;

wherein the semi-rigid, resilient leg portion includes a plurality of elongated, upwardly extending, substantially vertically oriented resilient members (Figure 11 and Figure 13: 412/452 and 486; Figures 14 and 19: 512/552 and 585; Figure 20: 712/752 and 786) which are spaced apart in the sagittal plane intermediate their upper and lower ends, and which are anterior facing convexly curved at their lower ends (Figure 11 and Figure 13: lower end 434/424 and lower end 491; Figure 20: lower end 734/724 and lower end 791) to form an ankle area of the prosthesis and which extend upwardly above the ankle area to a substantially vertically oriented upstanding upper end of the leg portion, at least one of said plurality of resilient members (e.g., 412) is wider in the frontal plane than thick in the sagittal plane, the resilient leg portion storing energy during force loading of the prosthesis and return the stored energy during force unloading (e.g., controls anterior movement, and assists posterior movement) to increase the kinetic power generated for propulsive force by the prosthesis in gait.

Regarding claim 44, the figures clearly show the plurality of elongated members as fastened together at their upper and lower ends.

Regarding claim 46, the shank is 412/452 (Figures 11 and 13) and 712/752 (Figure 20), and the spring is 486 (Figures 11 and 13), 585 (Figures 14 and 19), and 786 (Figure 20).

Regarding claim 47 and claim 48, the “coupling means” is 495/496/497 (Figures 11 and 13) and 804/806 (Figure 20); the “fastener” is 488 (Figures 11 and 13) and 808 (Figure 20). The “stop” is 492/494 (Figures 11 and 13) and 794/798 (Figure 20).

Regarding claim 49, the “adapter” is any of the well known adapters/sockets attached to the top of the pylon. Or it could just be the upper-most end of the pylon.

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Regarding the embodiments showing a resilient “link assembly” (e.g., Figures 14 and 19), **Atkinson et al.** disclose in paragraph 0114 said assembly can be substituted by leaf springs. **Atkinson et al.** did not particularly disclose said leaf springs as “anteriorly facing convexly curved”. However, this is already known in the art. For example, each one of **Allen et al.** ‘767 and **Christensen** ‘665 teaches a prosthetic foot having a plurality of leaf springs that are anteriorly facing convexly curved in order to absorb, store, and release/return energy during a gait cycle, and to selectively alter the strength and/or stiffness of the prosthetic foot. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have combined the teaching of a prosthetic foot having a plurality of leaf springs that are anteriorly facing convexly curved, as taught by each one of **Allen et al.** ‘767 and **Christensen** ‘665, with the invention of **Atkinson et al.**, in order to absorb, store, and release/return energy during a gait cycle, and to selectively alter the strength and/or stiffness of the prosthetic foot.

While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). With regards to statements of intended use and other functional statements (e.g., *to increase the kinetic power; etc.*), they do not impose any structural limitations on the claims distinguishable over the device of **Atkinson et al.**, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA

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1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969).

### ***Response to Arguments***

**11.** Applicant's arguments with respect to claim 43 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

**12.** Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Javier G. Blanco whose telephone number is (571)272-4747. The examiner can normally be reached on M- F (10am-7:30pm), first Friday of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, ***please contact the examiner's supervisor, SPE David Isabella, at (571) 272-4749.*** The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

***If there are any inquiries that are not being addressed by first contacting the Examiner or the Supervisor, you may send an email inquiry to***

TC3700\_Workgroup\_D\_Inquiries@uspto.gov.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Javier G. Blanco/

Examiner, Art Unit 3774

/David H. Willse/

Primary Examiner, Art Unit 3738